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In re Application of : DECISION ON
Karin KLOKKERS et al. :
Application No.: 10/019,121 :
PCT No.: PCT/EP01/08071 : PETITION
Int. Filing Date: 12 July 2001 :
Priority Date: 12 July 2000 : UNDER 37 CFR 1.47(a)
Attorney's Docket No. 4271-34US :
For: Matrixkontrolliertes transdermales ... :
ACE-Hemmer :
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This is in response to the "PETITION UNDER 37 CFR §1.47" filed on 26 September 2002. The \$130.00 petition fee has been charged to petitioner's Deposit Account No. 03-2412 as indicated in "General authorization for payment of fees and petitions for extensions of time."

BACKGROUND

On 12 July 2001, applicants filed international application PCT/EP01/08071, which claimed priority of an earliest priority date of 12 July 2000. A DEMAND was filed on 12 February 2002 prior to the expiration of 19 months from the priority date electing the United States. Accordingly, the thirty (30) month time period for paying the basic national fee in the United States of America expired at midnight on 12 January 2003.

On 21 December 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the Transmittal Letter.

On 01 March 2002, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from its 01 March 2002 date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 26 September 2002, applicant filed the present petition accompanied, inter alia, an executed Declaration without the signature of SENDL-LANG, Anna.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

“...Where a refusal of the inventor to sign the application paper is alleged, the circumstances of the refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.”

Applicants have satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

The averments of the petition are insufficient to support a finding that the nonsigning inventor, Ms. Anna SENDL-LANG refuses to sign. In this case, it has not been sufficiently demonstrated that a complete copy of the application papers were presented to the nonsigning inventor. Petitioners have provided no proof to corroborate that a complete application was sent (specification, including claims, drawings, and oath or declaration) since only the declaration was mentioned as being sent to her last known addresses. In addition, petitioner has not submitted copies of documentary evidence such as a copy of the registered returned envelope, a certified mail return receipt, a cover letter instructions, and etc., as required by MPEP Section 409.03 to support their allegation about the registered letters sent to Ms. Sendl-Lang. Consequently, it is unclear if she actually received the documents.

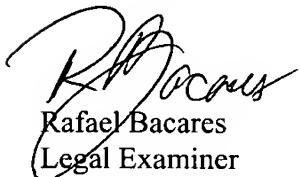
Consequently, the petition does not include sufficient factual proof that Ms. Sendl-Lang refused to sign the required documents.

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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